REMARKS

Claims 10 and 15 have been amended. Claims 10-16 are pending in the application. Reconsideration is respectfully requested.

Information Disclosure Statement

The Examiner is thanked for his correction of the patent number of the McCullough patent in Applicants' April 7, 2004 Information Disclosure Statement. Per the Examiner's request, Applicants are providing a Supplemental Information Disclosure Statement with copies of the two PCT International Search Reports cited in the Information Disclosure Statement dated April 7, 2004 for scanning purposes. Applicants presume that the Examiner does not need copies of the two European references cited in the April 7, 2004 IDS because the Examiner included the European references in his Form PTO-892 attached to the Office Action. If Applicants are incorrect and the Examiner does need copies of the European references, the Examiner is respectfully invited to contact the undersigned and they will be promptly provided.

Claim Rejections

Claim 10

Claim 10 was rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,769,184 to Whited in view of U.S. Patent No. 5,664,332 to Whited et al. It is respectfully submitted that the Whited '184 patent cannot be applied as prior art under

35 USC 103(a). The cited '184 Whited patent issued on August 3, 2004 and had a filing date of July 22, 1998. The present application has an effective provisional patent application filing date of October 6, 1999. Thus, the Whited '184 patent could only be applied as prior art under 35 USC 102(e).

Bettcher Industries, Inc. is the assignee of both the present application and the Whited '184 patent. Further, at the time the respective inventions were made, the inventor of the Whited '184 patent (Mr. Whited) and the inventors of the present application (Messrs Whited, Leimbach and Herrmann), as employees of Bettcher Industries, Inc., each had an obligation to assign the respective inventions to Bettcher Industries, Inc. Accordingly, pursuant to 35 USC 103(c), the Whited '184 patent is not prior art to the claims of the present invention and must be withdrawn.

The secondary reference, the Whited et al. '332 patent, does not disclose, teach or suggest a number of features of claim 10 including an annular blade supporting member having a split housing and a clamping assembly including a clamp member and fasteners wherein selectively reducing the clamping force at one of the fasteners permits expanding the split housing to facilitate removal of the blade from the blade supporting member while the split housing remains firmly assembled to and positioned on the head member. Thus, claim 10 is patentable.

Claims 11-14

Claims 11-14 were rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 4,178,683 to Bettcher. Part (f) of claim 1 recites: "an inner bearing face extending circumferentially along the radially inner side of said body mounting structure,

said inner bearing face located axially between said blade supporting section and said distal ends of said projections, said inner bearing face being axially narrow compared to the axial extent of either said housing body or said projecting bearing faces". The inner bearing face is described at page 6, lines 18 of the specification. The annular split body 15 of the Bettcher '683 patent does not disclose, teach or suggest any such axially narrow inner bearing face. Nor does the Bettcher '683 patent disclose, teach or suggest the radially outwardly opening groove recited in part (b).

For all of these reasons, claim 11 is patentable.

Claims 12-14 depend, directly or indirectly, from claim 11 and, therefore, are also patentable.

Claim 15

Claim 15 was rejected under 35 USC 103 as being unpatentable over U.S. Patent No. 4,854,046 to Decker et al. in view of U.S. Patent No. 4,575,937 to McCullough. Claim 15 has been amended to clarify that the steel actuator member is operatively coupled to the steel support such that when the steel actuator member is moved in a downward direction with respect to the handle assembly along said second line of action, the steel is moved along said first line of action into engagement with the blade.

The Decker et al. '046 patent does not disclose, teach or suggest a steeling mechanism having a steel actuator member and a steel member have two different lines of action. The secondary reference, namely the McCullough '937 patent does not remedy the deficiency of the Decker et al. '046 patent. First, the McCullough '937

patent does not disclose, teach or suggest a steeling mechanism. Thus, there is no motivation within the four corners of the McCullough '937 patent to modify the structure of the blade sharpener 48 of the Decker et al. '046 patent. As the Federal Circuit Court of Appeals has repeatedly warned, motivation to combine references cannot come from hindsight reconstruction based on the claimed invention:

> "'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' Although couched in terms of combining teaching found in the prior art, the same inquiry must be carried out in the context of a purported obvious 'modification' of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. ... Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'"

In re Fitch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

The Examiner's use of the depth control gauge 1 disclosed in the McCullough '937 patent as a basis for modification of the single line of action blade sharpener 48 disclosed in the Decker et al. '046 patent is based solely on impermissible hindsight reconstruction given what is disclosed and claimed in the present invention.

Further, in the depth control gauge 1 of the McCullough '937 patent, pressing the lever end 66 downwardly toward the handle assembly raises of the control plate 25 away from the blade 7. This teaches away from the structure recited in claim 15

wherein movement of the steel actuator member in a downward direction with respect to the handle assembly causes the steel to be moved into engagement with the blade.

For all these reasons, claim 15 is patentable.

Claim 16

Claim 16 was rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 4,894,915 to Decker et al. Claim 16 recites that at least a portion of a first drive transmitting surface is disposed on a radial line passing through the axis of the blade driving output member. Claim 16 further recites at least a portion of the second drive transmitting surface is disposed on a radial line passing through axis the axis of the blade driving member when said first and second drive transmitting surfaces are engaged.

As can be seen in Figures 2, 4, 9 and 10 of the Decker et al. '915 patent, no portions of the drive transmitting surfaces disclosed in the Decker et al. '915 (68a in Figures 2 and 4 and 184, 185, 198, 199 in Figures 9 and 1) are disposed on a radial line passing through the axis of the driving output member. Thus, claim 16 is patentable.

Conclusion

All pending claims are believed to be in condition for allowance and prompt notification to that effect is respectfully requested.

Respectfully submitted,

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